

76 (NEW). The method of claim **63** or **64**, wherein the nuclear hormone receptor is selected from the group consisting of: a glucocorticoid receptor, an androgen receptor, a progestin receptor, an estrogen receptor, a vitamin D receptor, a retinoid receptor, an icosanoid receptor, and a peroxisome receptor.

REMARKS

STATUS OF THE CLAIMS

Claims 63-76 are pending with entry of this amendment, claims 18, 41, 61 and 62 being cancelled, and claims 63-76 being added herein. These amendments and new claims are to be entered without prejudice and are not to be construed as abandonment of the previously claimed subject matter or agreement with any objection or rejection of record. These amendments introduce no new matter and support for the new claims is replete throughout the specification.

For Example, with respect to claims 63 and 64, support is found throughout the application, e.g., at page 2, line 24- page 3, line 10; page 6, line 3- page 7 line 11; page 15, line 16- page 16; line 23; page 27, line 1- page 36, line 3; and throughout the appendices and figures. Support for claims 65, 66 and 67 is found, e.g., at page 16, line 26- page 21, line 2; and in the figures and appendices. Support for claim 68 is found, e.g., in the appendices and the various text references in the specification to the appendices. Support for claim 69 is found, e.g., in Examples 9 and 10. Support for claims 70 and 71 is found, e.g., at pages 27-34. Support for claim 72 is found, e.g., at page 10, lines 30-31 and throughout the following passages of the specification. Support for claim 73 is found e.g., beginning at page 21, line 7. Support for claim 74 is found, e.g., at page 47. Support for claim 75 is found throughout. Support for claim 76 is found e.g., at page 6, line 27- page 7, line 11. Additional support for the new claims is replete throughout the application as originally filed.

Applicants submit that no new matter has been added to the application by way of the above Amendment. Accordingly, entry of the Amendment is respectfully requested.

THE INFORMATION DISCLOSURE STATEMENT.

Applicants note with appreciation the Examiner's thorough consideration of the references cited in the Information Disclosure Statement (Form 1449) submitted on November 28, 2000.

REJECTIONS OF THE CLAIMS

With cancellation of the previously pending claims and entry of new claims 63-76, the rejections of record are believed to be overcome. Applicants traverse the rejections to the extent that the rejections are applied to the new claims.

Claim Objections

Claims 18, 41, 61 and 62 were objected to for informalities in that, as the Examiner correctly pointed out, "Appendix 1" and "Appendix I" were used inconsistently in the claims relative to the specification. The new claims correctly refer to the various Appendices.

Rejections for Non-Statutory Subject Matter

Claims 18, 41, 61 and 62 were rejected for allegedly reading on products of nature. The new claims relate to various methods, rather than the products of those methods *per se*, rendering the rejections moot.

Rejections for Undue Experimentation

Claims 18, 41, 61 and 62 were rejected for allegedly requiring undue experimentation to determine all possible products of the methods, as well as for various informalities, such as improper incorporation by reference of claimed subject matter. Because the new methods do not present similar issues, the rejection is believed to be overcome.

For example, with respect to the incorporation by reference issue for Appendix 1, this limitation no longer appears in the claim. With respect to the undue experimentation rejection, the claims are thoroughly exemplified, and can certainly be practiced without undue experimentation. That is, under the "Forman Factors," correctly identified by the Examiner as being pertinent to determining whether the invention can be practiced without undue experimentation, the claims certainly pass muster. That is, the level of skill in the relevant art is high (Ph.D., at least), the amount of experimentation is modest

(requiring, at most, extension of Applicants' working examples to highly similar systems, which can be tested by completely routine techniques), there are many working examples provided (plus complete crystal structure information), the state of the prior art is advanced (crystallography, molecular modeling and nuclear receptors had all been the subject of decades of prior work), and the level of unpredictability to fully practice the scope of the claims, given Applicants' extensive teaching, is low.

Rejections for Indefiniteness

The claims were rejected for alleged indefiniteness for various informalities. All of these issues have been overcome by deleting the rejected claims.

Rejections for Anticipation/Obviousness

Claims 18, 41, 61 and 62 were rejected for alleged anticipation/ obviousness, in that the products of the recited process were argued to read on available compounds. That is, the Examiner identified references that allegedly teach compounds with the same structure as those identified by the various processes at issue, albeit made by different processes.

To facilitate prosecution, the claims have been redrafted to focus on relevant methods, rather than products thereof. These simply do not present the same issues identified for consideration by the Examiner with respect to the prior art. That is, because the cited references do not teach the limitations of the processes now claimed, they cannot render the claimed invention obvious or anticipated. Accordingly, the rejection should be withdrawn.

CONCLUSION

In view of the foregoing, Applicants believes all claims now pending in this application are in condition for allowance. All of the rejections of record are overcome by the cancellation of the previously pending claims and the entry of the new claims above. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the claims are deemed by the Office not to be in condition for allowance, after consideration of this Response, a telephone interview with the Examiner is hereby requested.

Please telephone the undersigned at (510) 337-7871 to schedule an interview, if necessary.